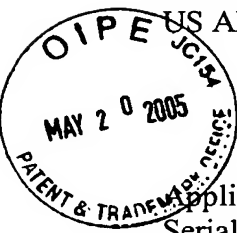


JPW

RESPONSE

US APPLN. NO. 10/772,721



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

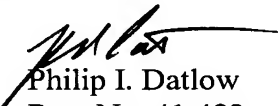
Application of: Yoakim, Christiane et. al.) Art Unit: 1626
Serial No.: 10/772,721) Examiner: Saeed, Kamal A.
Conf. No.: 5605)
Filed: 2/4/2004
For: Inhibitors of Papilloma Virus
Docket No.: 13/073-1-D1

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this correspondence is being deposited with the U.S.
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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on May 18, 2005

By: 
Philip I. Datlow
Reg. No. 41,482

RESPONSE

Sir:

This is in response to the Office Action dated April 20, 2005, setting forth a 1 month period for reply. At page 2 of the office action, the examiner sets forth a restriction requirement in 2 groups:

- I. Claims 1-26, drawn to a products
- II. Claims 27-29, drawn to a methods of use

The examiner also requires an election of single compound as an elected species.

In response, Applicants herein elect Group I, with compound 1052 in Table 1 at page 61 as the elected species. This election is made with traverse.

Applicants traverse the restriction requirement for the following reasons: In arguing for distinction between Groups I and II, the examiner argues that “the product as claimed can be used in a materially different method with as shown in claims 38-46.” Since there are no claims 38-46 in the present application, Applicants do not understand this argument. Since no valid basis for patentable distinction has been presented, Applicants respectfully submit that this Restriction Requirement is improper and should be withdrawn. Moreover, Applicants submit that examination of the method claims would not impose an undue burden since the method claims depend upon the compound claims of Group I and therefore the prior art search of the compound and method claims would be co-extensive. For the foregoing reasons, Applicants respectfully submit that the restriction requirement is improper and should be withdrawn.

Applicants also traverse the election of species requirement. Applicants submit that, at the very least, the compounds of formula (I) as depicted in claim 1 constitute a proper Markush Group of compounds as they all share a common structural core and all share a common utility as inhibitors of the papilloma virus for the treatment of papilloma virus infection. Accordingly, Applicants elect a single disclosed species herein on the understanding that this is done only to facilitate initial search and examination, but that this application will be generically examined in according with the USPTO’s Markush Practice as outline in MPEP 803.02 in the event that the elected species is found to be patentable.

Applicants appreciate the Examiner’s acknowledgment (at pgs. 5-7 of the Office Action) that the USPTO’s Rejoinder Practice (MPEP 821.04) is applicable to the present application. In the event that the product claims of Group I are found to be allowable, Applicants request that the process (method) claims of Group II be rejoined in the examination under Rejoinder Practice since all these process claims depend from the product claims of Group I.

In view of the above remarks, Applicants respectfully submit that this application is now in condition for early examination. If any points remain at issue which can best be resolved by

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way of a telephonic or personal interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



Philip I. Datlow
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